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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,277	07/09/2001	Osamu Nagata	7217/64520	7556

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LERNER, DAVID, LITTENBERG,  
KRUMHOLZ & MENTLIK  
600 SOUTH AVENUE WEST  
WESTFIELD, NJ 07090

EXAMINER
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PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
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2627

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/901,277

Applicant(s)

NAGATA ET AL.

Examiner

Aristotelis M. Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

Applicants' response of 5/22/06 has been considered with the following results.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

1. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 1 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed on 8/12/02. In that paper, applicant elected the invention of Group I, i.e., a product, and this election indicates that the invention is different from what is defined in the claim(s) because as presented/amended, the ultimate wherein clause is drawn to desired results that occur from the existence of an "editing" operation, i.e., method limitation(s) and not necessarily drawn to just a product/nor to a product with respect to the "block movement" as originally found in this group of claims.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 1 is rejected under 35 U.S.C. 101 because:

Applicants' attention is drawn to the newly available "interim guidelines" with respect to 101/statutory subject matter available at "[www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf)".

The following claim analysis is made:

Claim 1:

A recording medium

Analysis:

product

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having a program area for recording  
a plurality of programs, the plurality of programs  
being managed into a plurality of groups  
said recording medium comprising:

arbitrary designation  
& desired use  
How managed?

a management area for recording  
management information that includes:

well know toc areas  
on all discs

first management information  
for managing storage of a plurality of program  
names whereby a given one of the plurality  
of program names  
corresponds to a particular one of the  
plurality of programs recorded in the  
program area;

management information  
group name?

second management information  
for managing associations between  
the plurality of programs and the plurality of  
groups whereby specific ones of the  
plurality of programs are associated  
with a given one of the plurality of groups,  
and including a first special code  
for partitioning program numbers corresponding  
to the programs associated with the given  
group name associated with the

abstract idea/ information/  
? how does this manage?

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given group, and a  
a second special code for partitioning  
the program numbers and group name associated  
with the given group and the program numbers and  
the program numbers and group name associated  
with another one of the plurality of groups,  
wherein a respective one of the plurality  
of groups is erased, moved or divided by  
editing at least one of the program numbers  
and the group name associated with that  
group.

In the above analysis, applicants' attention is drawn to the above interim guidelines starting at page 12, and particularly focusing upon pages 14-17, page 22 and finally at 56-57 thereof.

The examiner has interpreted the above claims as being drawn to

- a) either an abstract idea – information, or alternatively
- b) a compilation of data.

### ***Response to Arguments***

Applicant's arguments filed 5/22/06 have been fully considered but they are not persuasive. The claimed subject matter is not drawn to statutory subject matter as analyzed above. No oersuasive argument has been presented.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple

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assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4/1 & 3/1 of U.S. Patent No. 6,580,679 in view of Matsumoto et al (6,462,263) and all further considered with Sakai (4905185).

The following analysis is made:

Pending Claim 1 .	6580679
A recording medium	claim 1 lines 1-3
having a program area for recording	inherently present
a plurality of programs, the plurality of programs	
being managed into a plurality of groups	
said recording medium comprising:	
a management area for recording	
management information that includes:	
first management information	claim 1 lines 4-8
for managing storage of a plurality of program	
names whereby a given one of the plurality	
of program names	
corresponds to a particular one of the	

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plurality of programs recorded in the

program area;

and

second management information

claim 1.lines 9-11, claim

for managing associations between

the plurality of programs and the plurality of

groups whereby specific ones of the

plurality of programs are associated

with a given one of the plurality of groups,

and including a first special code

4 – see further analysis below

for partitioning program numbers corresponding

to the programs associated with the given

group name associated with the

given group, and a

a second special code for partitioning

the program numbers and group name associated

with the given group and the program numbers and

the program numbers and group name associated

with another one of the plurality of groups,

wherein a respective one of the plurality

of groups is erased, moved or divided by

editing at least one of the program numbers

and the group name associated with that

group.

The above claims are obvious because although the partitioning ability provided by the claimed separating information is not found in the above patent, such is taught by the Matsumoto et al reference, see the discussion with respect to the delimiters at col. 3 lines 5-9. The examiner interprets

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these as teaching a plurality of delimiting codes, hence meeting both the claimed first and second "special code" for partitioning.

The existence of editing capabilities for a "group" /i.e., a block is further taught by the Sakai reference see the description of the summary of the invention – starting at column 1, line 40. See the discussion with respect to figure 5 for "erasing".

It would have been obvious to modify the base system of the above noted patent (claims 4/1 & 3/1) with the above teaching from Matsumoto, motivation is to permit easily recognizable data fields, and hence reduce confusion and processing time.

Hence the ability of having such a capability flowing from a partitioned record is considered met by the above combined references.

#### ***Response to Arguments***

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1 is rejected under 35 U.S.C. 103(a) as obvious over JP 10-336579 further considered with and Matsumoto et al.

. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

The following analysis is made.

Claim 1:	MAT of JP document
A recording medium	see abstract
Having a program area for recording	area inherently present,
a plurality of programs, the plurality of programs	area other than the toc

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being managed into a plurality of groups

said recording medium comprising:

a management area for recording management

toc table

information that includes:

first management information for

see paragraph 24 of MAT/ group list/name

managing storage of a plurality of program

names whereby a given one of the plurality

of program names corresponds to

a particular one of the pluralities of programs recorded in

the program area; and

second management information

program names present

for managing associations between the plurality

see paragraph 31 of the MAT

of programs and the plurality of groups whereby

specific ones of the plurality of programs are

associated with a given one of the plurality of

groups, and including

a first special code for partitioning

see secondary reference and

program numbers corresponding to the

further analysis below

programs associated with the given group

and a group name associated with the given

group and the program numbers and group name

associated with another one of the plurality of groups,

wherein a respective one of the plurality of groups is

erased, moved or divided by editing at least one

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of the program numbers and the group name associated with that group.

In the above analysis, the examiner interprets that the primary reference/base reference to the JP document lacks the specific mentioning of information/ special codes for “partitioning” as recited in the above claim. See the further discussion with respect to mat paragraph 64 that discusses an editing ability – which the examiner interprets meets the desired wherein clause of the claim with respect to an “erase” capability.

Nevertheless, as further taught in this environment by Matsumoto, the use/ability of having a plurality of special codes used for partitioning all manners of information is found. See the above description of the “delimiting” ability in Matsumoto et al starting at col. 1, lines 15-39 further describing figure 1 and col 3 lines 5-9. The examiner interprets the Matsumoto et al reference for teaching the ability of having appropriate delimiters (special codes) for designating separate fields of attribute information, i.e., names, artist, music, tracks, etc. – see additionally col. 1 line 48 to col. 2 line 2.

### ***Response to Arguments***

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-F: 6:00 - 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aristotelis M Psitos  
Primary Examiner  
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A handwritten signature in black ink, consisting of a series of loops and a long horizontal stroke at the bottom.

AMP